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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,292	10/29/2001	Susan M. Milberger	020375-000240US	9347

20350 7590 09/09/2004

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EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3624

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,292

Applicant(s)

MILBERGER ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-27 are pending in this communication filed 05/18/04 as Appeal Brief.
2. The Finality of the 07/12/03 Rejection is hereby withdrawn in view of the new ground(s) of rejection as set forth here below.
3. The following references are missing from Applicant's file: EP 0949569; DP 1077436; PCT W0 00/22559; W0 00/54122; W0 00/67177; W0 00/79452; and W0 01/04816. Applicant is respectfully requested to submit these references for consideration in order to give the application a proper examination.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 10, 11, 16, 17, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10, 16, and 20 reads "a computer-readable medium having executable instructions for performing ...". These claims appear to be independent claims because the claims are usually used with a computer system. For example: a computer readable medium bearing executable instructions for "; the computer-readable medium of claim 10, wherein said instructions are further arranged to cause the one or more computer processors to perform the step of".

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Claim 17 recites a "second listed transferring step". It is unclear from the claim language what the Applicant means by the "second listed transferring step". Does Applicant mean "transferring money from the handler to the stored value fund"?

Claim 11 recites the limitation "a handler" and "the handler" in lines 3 and 4 then in line 11 recites "a second handler". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,920,847) Kolling et al, hereafter Kolling in view of (US 6,408,284) Hilt et al, hereafter Hilt.

Claims 1 and 11. Kolling teaches, A method for automatically processing a recurring transfer request from a stored value fund with an online system, the method comprising: determining a handler associated with a payor (col. 19, lines 44-49, fig. 8 (102, 12, 14, 16, & 18); transferring money from the handler to the stored value fund (col. 21, lines 43-61); informing the payor that a payee accepts payment from the online system (col. 19, lines 1-24); receiving pay-out instructions that include at least two of a payor identifier, a payee identifier, a transfer amount, a payment description (col. 26,

lines 25-47); and transferring the transfer amount from the stored value fund to the payee automatically (col. 26, line 66-col. 27, line 15 and lines 78-46).

Kolling failed to teach, receiving subscription type information which includes at least two of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period. Hilt teaches, receiving subscription type information which includes at least two of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period (col. 7, lines 39-48, col. 8, lines 23-30, and col. 10, lines 7-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to receive subscription type information which includes at least two of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period and to modify in Kolling because such a modification would allow Kolling to have a bill paying system that pays a set amount of money at periodic intervals after identifying the payee.

Claim 11. Hilt further teaches, "transferring a transfer amount from the stored value fund to a second handler associated with the payee automatically (col. 10, line 65-col. 11, line 28).

Claim 2. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the second-listed transferring step comprises transferring the transfer amount to a second stored value fund associated with the payee (col. 15, lines 22-46).

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Claims 3, 12, and 18. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the second-listed transferring step does not require any human interaction to fulfill the pay-out instructions (col. 15, line 55-col. 16, line 6).

Claims 4 and 19. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the second-listed transferring step comprises transferring the transfer amount to a second handler associated with the payee (col. 16, lines 7-28).

Claims 5 and 13. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 4, wherein the second handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program, a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer (col. 1, lines 22-34). The second handler being one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program, a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer are merely a design choice because a bank can issue a money order, a credit or debit card can have a mileage program or issue a gift certificate. A money order, a gift certificate, and an airline mileage program contain a value and a credit card and a debit card has a credit limit which could be presumed to be a stored value.

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Claims 6 and 14. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program (fig. 13 (404 –visa customer service) and fig. 16 (528 –agent location; 510g –bank).

Claims 7, 15, and 17. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, further comprising a steps of: waiting a period of time between the sending step and the second-listed transferring step (col. 5, lines 30-43). Kolling failed to teach, sending notification to the payor after receiving the pay-out instructions and canceling the second-listed transferring step if the payor declines within the period of time. Hilt teaches, sending notification to the payor after receiving the pay-out instructions (col. 11, lines 56-63) and canceling the second-listed transferring step if the payor declines within the period of time (col. 1, lines 60-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to send a notification to the payor after receiving the pay-out instructions and canceling the second-listed transferring step if the payor declines within the period of time and to modify in Kolling because such a modification would allow Kolling to have the capability to send a message to a payor after receiving the payment message if sent within some period after the payment message for the transaction.

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Claim 8. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the transfer amount corresponds to at least one of currency, monetary value, airline mileage, promotional program points, gift certificate credit, and commodities (col. 7, lines 35-52).

Claim 9. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the payor, the handler and the payee are remotely located with respect to each other (col. 20, line 60-col. 21, line 15 and fig. 8).

Claims 10, 16, and 20. Kolling and Hilt failed to teach, A computer-readable medium having computer-executable instructions for performing the computer-implementable method for automatically processing the recurring transfer request from the stored value fund with the online system, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a computer-readable medium having computer-executable instructions for performing the computer-implementable method for automatically processing the recurring transfer request from the stored value fund with the online system and to modify in Kolling because such a modification would allow Kolling to have a computer-readable medium such as a memory for storing executable instructions to perform the steps of claims 10, 16, and 20.

Claim 21. Kolling teaches, The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, wherein the second-listed transferring step comprises a step of transferring the transfer amount in a plurality of transfers (col. 7, lines 3-7).

Claim 22. Kolling teaches, The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, further comprising a step of checking the pay-out instructions against the subscription type information (col. 9, lines 58-67 and col. 10, lines 1-14).

Claim 23. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the determining step comprises a step of determining by the online system a handler previously associated with a payor.(col. 11, lines 5-33).

Claim 24. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the stored value fund is hosted by the online system (col. 11, lines 34-67).

Claim 25. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the receiving steps receive information online at the online system (col. 12, lines 1-9).

Claim 26. Kolling teaches, The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in

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claim .I, further comprising a step of determining if the transfer amount violates any limits specified in the subscription type information (col. 12, lines 29-47 and col. 15, lines 47-63).

Claim 27. Kolling teaches, The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, wherein the fixed payment amount is a per-request limit (col. 16, lines 61-67 and col. 17, lines 1-14).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Jones et al (US 5,778,067) disclosed a value transfer system which allows a value to be transferred between electronic purses.

Gustan et al (US 6,012,048) disclosed an automated banking and bill payment system.

Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E. Colbert
September 4, 2004

A handwritten signature in black ink, appearing to read "Vincent Millin".

**VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**